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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,839	07/10/2003	Naoya Ichikawa	2809-0126P	9038
2292	7590	07/27/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,839

Applicant(s)

ICHIKAWA ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-8 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/842,903.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 071003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group III, claims 4-8 and 12-16 in the reply filed on 7/14/04 is acknowledged. The traversal is on the ground(s) that "it appears that the search and substantive examination issues overlap significantly between Groups II and III. It is further submitted that the search and substantive examination issues of Groups I and III also significantly overlap such that the subject matter of Group I should also be included within the examination of the present application ... [and] it appears that the search for the claims of Group III will include all of the listed classes, including the classes of Groups I and II ... [as such] it is submitted that there is no significant burden placed on the Examiner to examine at least additionally the subject matter of Group III, and further the subject matter of Group III".

This is not found persuasive because of reason already stated in the written restriction requirement. These inventions have acquired a separate status in the art as shown by their different classification, the search required for Group III is not required for Group I or II, and the search required for Group II is not required for Group I or III.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-3 and 9-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4, 5, 7, 12, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto et al. (JP 10279607).

In the abstract, Miyamoto et al. teach a method of producing a rubber product, which comprises adding a protease, a rosin acid salt (water-soluble resin) and 3 to 10 phr of an inorganic salt (heat sensitizer as defined by applicant) to a natural rubber latex, thereby subjecting the natural rubber latex to a deproteinization treatment, incorporating at least a vulcanizing agent into the latex, and vulcanizing (and drying) a rubber film formed on a mold such as for surgical gloves.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

5. Claims 4-8 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (WO 96/28500).

In col. 3, lines 1-16, col. 5, lines 48-53, col. 6, lines 16-51 and col. 10, lines 27-45 of US 5,910,567, which is the English language translation of WO 96/28500, Tanaka et al. teach a method of producing rubber products, which comprises adding a protease, 0.1 to 10 phr of hydroxy functional water-soluble polymer surfactant/water-soluble

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activator (heat sensitizer as defined by applicant) combination to a natural rubber latex, thereby subjecting the natural rubber latex to a deproteinization treatment, incorporating at least a vulcanizing agent into the latex, and vulcanizing (and drying) a rubber film formed by dip forming on the mold such as for surgical gloves or condoms.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (USPN 5,585,459) in combination with Miyamoto et al. or Tanaka et al. (WO 96/28500).

In col. 1, lines 48-56, col. 7, lines 35-57, and col. 8, lines 8-18, Tanaka et al. (US'459) teach a method of producing rubber products, which comprises adding a protease, an acid functional coagulation assistant [water-soluble polymer of step (1)] and 0.01 to 10% of a coagulating assistant [water-soluble polymer of step (2)] to a natural rubber latex, thereby subjecting the natural rubber latex to a deproteinization treatment. incorporating.

Tanaka et al. (US'459) differ from the claimed invention in that they don't discuss the vulcanization of the raw rubber product. However, it is known in the art and would

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have been expected to vulcanize said raw deprotenized rubber, for the purpose of producing rubber product such as surgical gloves, such as taught by Miyamoto et al. or Tanaka et al. (WO), above.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to vulcanize the raw deprotenized rubber of Tanaka et al. (US'459) in order to obtain the advantages taught by Miyamoto et al. or Tanaka et al. (WO), motivated by a reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KCE

**KELECHI C. EGWIM PH.D.**  
**PRIMARY EXAMINER**